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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/666,207 | 09/21/2000 | Kevin R. Orton | ORTONK.003A | 9101 |
| 20995 | 7590 | 01/09/2004 | EXAMINER | |
| KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614 | | | DEAK, LESLIE R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3762 | 15 |
| DATE MAILED: 01/09/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|-----------------------------|-----------------|-------------------|
| Offic Action Summary | Application No. | Applicant(s) |
| | 09/666,207 | ORTON, KEVIN R. ✓ |
| Examiner | Art Unit | |
| Leslie R. Deak | 3762 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 and 5-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 September 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3 and 5-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 4,822,339 to Tran. Tran discloses a container 322 with at least one wall and a cavity or a reservoir, two electrodes 324 and 326 that are spaced apart and attach from the inner wall and extend into the reservoir. The electrodes pass through the container, thereby coming into contact with the outside surface of the container, and connect to leads or contact elements 346 and 348 outside the reservoir (see FIG 1). The container further comprises a sealing element as illustrated in FIG 10 (see column 5, lines 50-60, column 10, lines 45-67, FIG 10). Tran discloses a pierceable sealing element 340 on a secondary container 338, and illustrates a seal and a pierceable closure on both the secondary container 338 and the primary container 322 (see FIG 10). The container further comprises a therapeutic agent that may be transferred to a patient (see FIGS 1,

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2, and 10, column 8, lines 18-29). Tran discloses that while the apparatus holds a liquid, an electrical charge is applied between the electrodes, and the therapeutic agent is then transferred to the patient by appropriate delivery means, which includes an "applicator" as claimed by applicant. Tran further discloses an alternate embodiment of the container (see FIG 3) that includes both electrodes in a single undivided chamber 218 defined by housing 228. See FIG 3, column 9, lines 62-67.

Tran fails to disclose that the sealing portion is "cooperating" with the outside surface of the container. However, as illustrated in FIGS 1 and 10, the sealing portion of the Tran device is flush with the outer surface of the container, sealing the container up to the outside surface and protecting from contamination. Since both sealing portions protect the containers from contamination and seal to the outside surface of the container, the sealing portion of the Tran device "cooperates" with the outside surface of the container in that it works along with the container to protect from contamination. In the alternative, it would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the sealing portion of the Tran device to "cooperate" with the outside surface of the container, since it has been held that rearranging parts of an invention involves only routine skill in the art. See MPEP 2144.04.

With regard to applicant's claim that the container is "adapted to" hold a liquid and that the sealing portion is "adapted to" reseal, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires

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the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie R. Deak whose telephone number is 703-305-0200. The examiner can normally be reached on M-F 7:30-5:00, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703-308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

Lrd 
5 January 2004



ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700